



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,487	09/30/2003	Toshihiko Matsuo	MATSUO3	1529

7590 12/23/2005
BROWDY AND NEIMARK, P.L.L.C.
624 Ninth Street, N.W.
Washington, DC 20001-5303

EXAMINER

SHIAO, REI TSANG

ART UNIT	PAPER NUMBER
----------	--------------

1626

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,487

Applicant(s)

MATSUO ET AL.

Examiner

Robert Shiao

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on responses filed on 11/04, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application claims benefit of the foreign application:
JAPAN 285784/2002 with a filing date 09/30, 2002.
2. Amendment including cancellation of claims 7-12 and addition of claims 13-17 in the amendment, and a declaration under 37 CFR 1.132, filed on November 04, 2005 is acknowledged. Claims 1-6 and 13-17 are pending in the application. No new matter is found. Since the newly added claims 13-17 are commensurate with the scope of the invention, therefore, claims 1-6 and 13-17 are prosecuted in the case.

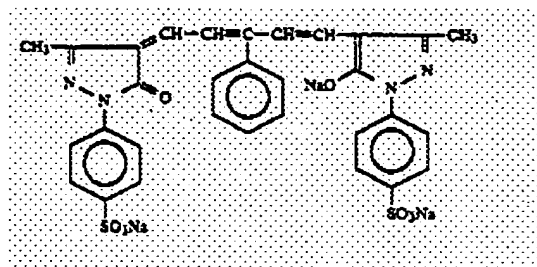
Responses to Amendment/Arguments

3. Since claims 7-12 have been cancelled, therefore rejection of claims 7-12 under 35 U.S.C. 112, first paragraph, is obviated herein.
4. Since claims 7-12 have been cancelled, therefore rejection of claims 7-12 under 35 U.S.C. 102(b) or 103(a), is obviated herein.
5. The newly added claims 13-17 are drawn to a product an artificial material comprise a biocompatible high molecule (i.e., silicon) and an organic dye (polymethine organic dye). It is noted that the intent of use of the preamble "which can be substituted for a part or the whole of the function of the retinase of animal including human", does not obtain any patentability weight. Claims 13-17 still render obviousness over Koshiishi et al. US 5,132,095.

Koshiishi et al. disclose a specific substance (i.e., artificial material) comprises

Art Unit: 1626

polymer (i.e., a biocompatible high molecule silicon) and potential-sensitive dye (i.e., polymethine organic dye). A dye of a formula, i.e.,



, is particularly exemplified, see column 8, lines 35-68, and column 9, lines 37-50. Koshiishi et al. specific substance can be used as a sensor or detecting device.

The difference between the instant claims and Koshiishi et al. is that Koshiishi et al. silence the instant artificial material can be substituted for a part or the whole of the function of the retinase of animal including human.

One having ordinary skill in the art would find the claims 13-17 *prima facie* obvious because one would be motivated to employ the specific substance (i.e., artificial material) of Koshiishi et al. to obtain instant artificial material, wherein comprise a biocompatible high molecule (i.e., polymer or silicon) and an organic dye (i.e., polymethine organic dye). Moreover, Something which is old does not become patentable upon the discovery of a new property, see M.P.E.P. 2112. Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA1977).

The motivation to make the claimed artificial materials from the expectation

that the instant claimed artificial materials would possess similar activities, i.e., a substitute for a part or the whole of the function of the retinase from the known Koshiishi et al. artificial materials (i.e., specific substance) to that which is claimed in the reference.

6. Claims 13-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter “a biocompatible high molecule” and “an organic dye compound” without limitation, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, see claim 13, lines 1-7.

Claims 13-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the instant artificial material comprise silicon or a dye of formula (17), does not reasonably provide enablement for instant artificial material comprise a dye other than compounds of formulae 1-17 or a biocompatible high molecule other than the compounds of claim 15, i.e., a compound having morpholine moiety. The specification does not enable any person skilled in the art to which it pertains, with which it is most nearly connected, to use the invention commensurate in scope with these claims, see claim 13, lines 1-7.

Incorporation of limitation “a biocompatible high molecule” and “an organic dye compound”, i.e., the compounds of claim 15 and compounds of formulae 14-17 on page 10, would obviate the rejection.

Objection

7. Claims 1-6 and 13-17 are objected to as containing non-elected subject matter, i.e., an organic dye other than compounds of formula 14-17, etc. It is suggested that applicants cancel claims 1-6 and amend the claims 13-17 to the scope of the elected subject matter as defined on the page 2 of the Office Action, dated June 28, 2005.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.


Art Unit: 1626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAOFIQ SOLOLA
PRIMARY EXAMINER



Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626



Robert Shiao, Ph.D.
Patent Examiner
Art Unit 1626

December 7, 2005